

In re Application of:
QUOC N. DANG et al.
Application No.: 10/628,144
Filed: July 28, 2003
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PATENT
Docket No.: K35A1303

REMARKS

In the pending Office Action in the parent application, claims 1, 2, 6-9 and 13-20 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,018,789 to Sokolov et al. patent (the "Sokolov '789" patent) in view of U.S. Patent No. 5,875,352 to Gentry et al.

Applicants respectfully traverse each of the rejections and respectfully request reconsideration of the claims of this application in light of the following remarks.

The rejection of claims 1, 2, 6-9 and 13-20 as allegedly unpatentable over the Sokolov '789 patent in view of the Gentry et al. patent is respectfully traversed.

Applicants assert that the Sokolov '789 patent is not an appropriate reference under 35 U.S.C. 102(e) and seek disqualification of the Sokolov '789 patent as prior art under 35 U.S.C. 102(e) against the pending claims (see 35 U.S.C. §103(c)). In this regard:

U.S. Patent No. 6,018,789 (Sokolov et al.) was owned by Western Digital Corporation, and the inventors of invention of parent application No. 09/552,407 and the above-identified continuation application No. 10/628,144, which is a continuation of the parent application, were under an obligation to assign the invention of the parent application No. 09/552,407 and the continuation application No. 10/628,144 to Western Digital Corporation, at the time the invention of the parent application No. 09/552,407 and the continuation application No. 10/628,144 was made.

According to MPEP §706.02(1)(2), the above statement is sufficient to disqualify the Sokolov '789 patent. As additional evidence of common ownership, Applicants provide the following data. For U.S. Patent No. 6,018,789, an assignment from inventors, Daniel John Sokolov and Jeffrey L. Williams, to Western Digital Corporation is recorded beginning at Reel 8898, Frame 0004. The recordation date is November 24, 1997. For parent application number 09/552,407,

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assignments from inventors, Quoc N. Dang, Tsun Y. Ng, Ralph H. Castro, and Virgil V. Wilkins, to Western Digital Corporation is recorded beginning at Reel 010755, Frame 0385.

Applicants assert that the Effective Date of the the Sokolov '789 patent as prior art (either as a patent or a printed publication) under 35 U.S.C. § 102(a) against the above-identified continuation application is the patent's issue date of January 25, 2000. The attached Declarations by the inventors and the referenced exhibits show that the inventions defined by claims 1, 2, 6-9 and 13-20 were reduced to practice in the United States before the Effective Date (January 25, 2000) of the Sokolov '789 patent under 35 U.S.C. § 102(a). More specifically, the attached new Declarations establish reduction to practice of the each feature recited in claims 1, 2, 6-9 and 13-20 before the Effective Date of the Sokolov '789 patent by means of a "Rebel" disk drive, and the exhibits corroborate the existence of the Rebel disk drive before the Effective Date of the Sokolov '789 patent. Applicants note that an "accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself." See, MPEP 715.07. Applicants assert that the attached inventor Declarations submitted in accordance with 37 C.F.R. 1.131 shows invention of the claimed subject matter before the Effective Date of the Sokolov '789 patent under 35 U.S.C. § 102(a), and accordingly, swear behind the Effective Date of the Sokolov '789 patent.

Applicants respectfully assert that the rejections of claims 1, 2, 6-9 and 13-20 under 35 U.S.C. § 103(a) are now improper in light of the disqualification of the Sokolov '789 patent as prior art under 35 U.S.C. § 102(e) and the removal of the Sokolov '789 patent as prior art under 35 U.S.C. § 102(a). Accordingly, Applicants request allowance of claims 1, 2, 6-9 and 13-20.

Claim 15 was amended consistent with an amendment submitted in the parent application on October 30, 2002. Claim 17 was amended to correct a typographical error. Amended claim 17 is now consistent with claims 6 and 13.

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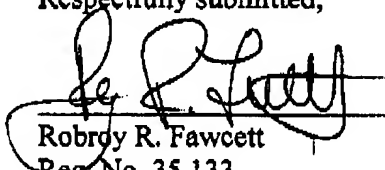
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CONCLUSION

In view of the above remarks, consideration and prompt evaluation of all pending claims are respectfully requested. If any questions or issues remain, the Examiner is invited to contact the undersigned at the telephone number set forth below so that prosecution of this application can proceed in an expeditious fashion.

Respectfully submitted,

Date: October 22, 2003


Robroy R. Fawcett
Reg. No. 35,133
Telephone: (760) 738-7005
Facsimile: (775) 255-6419

1576 Katella Way
Escondido, California 92027

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